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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,324	03/06/2002	Shunichi Abe	50083-216	7149
7590 10/03/2003 McDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096			EXAMINER NGUYEN, KHIEM D	
			ART UNIT 2823	PAPER NUMBER

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,324

Applicant(s)

ABE ET AL.

Examiner

Khiem D Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

DETAILED ACTION

Drawings

Figures 16A-D should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ichikawa et al. (U.S. Patent 5,970,322).

In re claims 1, 3, 10, and 11, Ichikawa discloses a method of manufacturing the semiconductor device comprising (See FIGS. 1(a)-(e) and related text): arranging at least a part of a portion of a lead frame (FIGS. 1(a)-(e), 1) that is to be sealed with a resin (FIGS. 1(c)-(e), 9, 16), and a portion that is to become an outer lead (FIG. 1(e), 1c), respectively, in a cavity (FIG. 1(c), 7) of a metal mold (FIG. 1(c), 5, 6); filling a sealing resin (FIGS. 1 (c)-(e), 9, 16) into the cavity of the metal mold, and hardening the sealing resin (col. 4, lines 11-33); and removing a member covering a surface layer region of the section, to become the outer lead, of the lead frame (col. 4, lines 34-64).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichikawa et al. (U.S. Patent 5,970,322) as applied to claims 1, 3, 10, and 11 above, and further in view of Utsumi et al. (U.S. Patent 6,603,194) and the applicant's admitted prior art (AAPA) of this application.

In re claims 2 and 9, Utsumi discloses wherein a plurality of semiconductor device constituent sections (FIG. 5A, 14) are arranged in a common cavity of the metal mold on the lead frame. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Ichikawa and Utsumi to enable a plurality of semiconductor device constituent sections of Ichikawa to be formed and furthermore to improve the quality of a resin-encapsulated semiconductor device while prolonging the life of a cutting blade, thus improving the productivity (col. 1, lines 60-65).

In re claims 4-8, AAPA discloses wherein spacers (FIG. 16C, 6) detachable from the section to become the outer lead are employed as the removable members (Background of the Invention, pages 1-3 and FIGS. 16A-D). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of

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Ichikawa, Utsumi, and AAPA to enable the spacers of Ichikawa to be formed and furthermore to obtain the outer leads.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khiem D Nguyen whose telephone number is (703) 306-0210. The examiner can normally be reached on Monday-Friday (8:00 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olik Chaudhuri can be reached on (703) 306-2794. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-9179 for regular communications and (703) 746-9179 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

K.N.
September 22, 2003


Olik Chaudhuri
Supervisory Patent Examiner
Technology Center 2800